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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,749	10/06/2003	Geoffrey Flagstad	14969US01	2813
23446 7590 11/28/2007 MCANDREWS HELD & MALLOY, LTD 500 WEST MADISON STREET SUITE 3400 CHICAGO, IL 60661			EXAMINER TOMASZEWSKI, MICHAEL	
			ART UNIT 3626	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/679,749

Applicant(s)

FLAGSTAD, GEOFFREY

Examiner

Mike Tomaszewski

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 5-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 5-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Notice To Applicant

1. This communication is in response to the Appeal Brief filed on 9/17/07. Claims 3-4 have been cancelled. Claims 1-2 and 5-64 are pending.

Pre-Appeal Brief

2. In view of the Appeal Brief filed on 9/17/07, the FINAL REJECTION IS HEREBY WITHDRAWN. New grounds of rejection are set forth below.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

- (A) Claims 1-2 and 5-64 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. More specifically, claims 1-2 and 5-64 are directed to non-statutory subject matter because these claims subvert existing

federal statutes, such as the Health Insurance Portability and Accountability Act of 1996 (HIPAA), through the use of the patent system and therefore, are against public policy.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2, 5-8, 11-32, 35-46, and 49-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Segal (US 2001/0041991; hereinafter Segal), in view of Joao (6,283,761; hereinafter Joao), and in view of Official Notice.

(A) As per previously presented claim 1, Segal discloses a method for a service provider to obtain a medical record of a patient from a covered entity in a form allowing said service provider to quickly disclose said medical record to a third party without restriction by the Health Insurance Portability and Accountability Act of 1996, the method comprising the following steps carried out by a service provider that is not the patient or a covered entity:

- (1) inducing said patient to receive said medical record from a covered entity (Segal: pg. 2, par. [0014]; pg. 12, par. [0151]) (Examiner notes Segal teaches that the patient has ownership and control of their medical records. As such, other parties interested in acquiring a medical record from a patient would be required to induce the patient to obtain their medical records for them.);
- (2) receiving said medical record from said patient in a storage format, without data processing said medical record (Segal: pg. 12, par. [0012]); and
- (3) storing said medical record in a memory in a form from which said medical record can be reproduced in said storage format (Segal: pg. 12, par. [0012]).

Segal, however, fails to *expressly* disclose a method for a service provider to obtain a medical record of a patient from a covered entity in a form allowing said service provider to quickly disclose said medical record to a third party without restriction by the Health Insurance Portability and Accountability Act of 1996, the method comprising the following steps carried out by a service provider that is not the patient or a covered entity:

- (4) storing said medical record *without data processing said medical record* [Emphasis added];

- (5) obtaining agreement in advance with the patient that the service provider shall transmit said medical record to a third party under defined conditions; and
- (6) transmitting said medical record to a third party when the defined conditions occur, without data processing said medical record.

Nevertheless, these features are old and well known in the art, as evidenced by Joao and Official Notice. In particular, Joao and Official Notice disclose a method for a service provider to obtain a medical record of a patient from a covered entity in a form allowing said service provider to quickly disclose said medical record to a third party without restriction by the Health Insurance Portability and Accountability Act of 1996, the method comprising the following steps carried out by a service provider that is not the patient or a covered entity:

- (4) storing said medical record *without data processing said medical record* (Joao: col. 2, lines 26-30; col. 3, lines 25-45; col. 4, lines 27-33; col. 6, lines 52-56);
- (5) obtaining agreement in advance with the patient that the service provider shall transmit said medical record to a third party under defined conditions (Official Notice: Examiner takes Official Notice that the technique of having one party (e.g., intermediary, middle man, straw man, *etc.*) perform certain actions on behalf of another party through an agreement is notoriously

well known and obvious. For example, a power of attorney, a proxy agreement, and executor/trustee agreements, are commonly used to obtain an agreement in advance between multiple parties to consummate an agreed course of action (e.g., transmission of medical records, *etc.*). Moreover, these techniques were developed and used prior to Applicant's invention to facilitate transactions.); and

- (6) transmitting said medical record to a third party when the defined conditions occur, without data processing said medical record (Official Notice: See step (5) above.).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Joao with the combined teachings of Segal and Official Notice with the motivation of providing healthcare information to pertinent parties (Joao: col. 7, lines 61-65).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Official Notice with the combined teachings of Segal and Joao with the motivation of facilitating transactions.

- (B) As per previously presented claim 2, Segal discloses the method of claim 1, further comprising:

said service provider inducing said patient to obtain possession of said medical record from said covered entity in a first format and said service provider inducing said patient to convert said medical record to said storage format, wherein said storage format is different from said first format (Segal: pg. 3, par. [0027]) Examiner notes Segal teaches a patient, "with guidance from their physician," obtaining their medical record in a first format (i.e., hard copy) and converting said medical record into a storage format (i.e., digital format via computer data entry).

- (C) As per original claim 5, Segal discloses the method of claim 1, wherein:
said memory is a portable medium (Segal: pg. 12, par. [0151]).
- (D) As per original claim 6, Segal discloses the method of claim 5, wherein:
said portable medium is an optical disc (Segal: pg. 12, par. [0151]).
- (E) As per original claim 7, Segal discloses the method of claim 1, further
comprising:
retrieving said medical record stored in said memory remotely through a
computer communications network (Segal: Fig. 1).
- (F) As per previously presented claim 8, Segal discloses the method of claim 1,
further comprising:
said service provider inducing said patient to update said medical record stored
in said memory (Segal: pg. 12, par. [0151]).
- (G) As per original claim 11, Segal discloses the method of claim 1, wherein:
said medical record is stored in a hierarchical storage system (Segal: Fig. 2a).
- (H) As per original claim 12, Segal discloses the method of claim 11, wherein:

said medical record is assigned to at least one file folder, said file folder containing medical records sharing at least one common attribute (Segal: Fig. 2a).

(I) As per original claim 13, Segal discloses the method of claim 12, wherein:

said file folder is assigned to at least one file template, said file template containing file folders sharing at least one common attribute (Segal: Fig. 2a).

(J) As per original claim 14, Segal discloses the method of claim 13, wherein:

a plurality of said file templates are stored in said storage system to form a general medical and personal information file of said patient (Segal: pg. 3, par. [0027]; Fig. 2a).

(K) As per original claim 15, Segal discloses the method of claim 12, wherein:

said file folder further comprises at least one sub-folder (Segal: Fig. 2a).

(L) As per original claim 16, Segal discloses the method of claim 11, wherein:

said hierarchical storage system provides hierarchical storage access (Segal: pg. 9, par. [0012]). Examiner notes also that, as a standard feature, data storage and operating systems (e.g., Microsoft Windows) enable a user to define multi-level access parameters to user designated files, folders, drives, databases, and/or applications, among other items.

(M) As per original claim 17, Segal discloses the method of claim 14, wherein:

access to a special file template is on a different basis than access to at least one other file template (Segal: pg. 9, par. [0012]). Examiner notes also that, as a standard feature, data storage and operating systems (e.g., Microsoft Windows) enable a user to define multi-level access parameters to user designated files, folders, drives, databases, and/or applications, among other items.

(N) As per original claim 18, Segal discloses the method of claim 7, wherein:

said special file template is an emergency file template (Segal: Fig. 2a).

(O) As per original claim 22, Segal discloses the method of claim 20, wherein:

said system is provided in the form of software (Segal: pg. 3, par. [0022]).

(P) Claims 19-21 and 23-29 substantially repeat the same limitations of claims 1, 2, 5-11 and 16, and therefore, are rejected for the same reasons given for those claims and incorporated herein.

(Q) Currently amended claim 30 substantially repeats the same limitations as amended claims 1 and 2 and therefore, is rejected for the same reasons given for those claims and incorporated herein.

(R) As per original claim 32, Segal discloses the system of claim 30, wherein:

said communication interface is adapted for acquiring said medical record from said patient in said storage format (Segal: pg. 7, par. [0099]; pg. 12, par. [0146]; Fig. 1 and Fig. 4).

(S) As per original claim 46, Segal discloses the system of claim 44, wherein:

said special file template is stored in a first memory and said general medical information file is stored in a second memory wherein said first and second memories are different optical discs (Segal: pg. 4, par. [0030]; Fig. 1).

(T) Claims 31, 35-45 and 47-49 substantially repeat the same limitations of claims 3-7, 8-18 and 20, and therefore, are rejected for the same reasons given for those claims and incorporated herein.

(U) As per previously presented claim 50, Segal discloses the method of claim 1, wherein said medical record is made by the covered entity before said inducing (Segal: par. [0121]).

(V) As previously presented claim 51, Segal discloses the method of claim 1, wherein said inducing occurs before the patient obtains possession of the medical record (Segal: par. [0024], [0027] and [0121]).

(W) As per previously presented claim 52, Segal discloses the method of claim 1, wherein the patient obtains possession of the medical record before said acquiring (Segal: par. [0121]).

(X) As per previously presented claim 53, Segal discloses the method of claim 1, wherein the patient has a computer with Internet access, and said inducing further comprises said service provider inducing said patient to obtain possession in said patient's computer of said medical record in digital form from a covered entity (Segal: par. [0024], [0026], [0027] and [0108], fig. 1).

(Y) As per previously presented claim 54, Segal discloses the method of claim 1, further comprising said service provider inducing said patient to acquire said medical record in a digital storage format without intervention of any entity or person other than said covered entity (Segal: Segal: par. [0024], [0026], [0027] and [0108], fig. 1).

(Z) Claims 55-64 substantially repeat the same limitations as those recited in claims 50-54 and therefore, are rejected for the same reasons given for those claims and incorporated herein.

6. Claims 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Segal, Joao, and Official Notice, as applied to claim 1 above, and further in view of Judson et al. (US 2005/0026117; hereinafter Judson).

(A) As per original claim 33, Segal discloses system of claim 30, wherein:

said communication interface is adapted to obtain the agreement of said patient to allow transmission of said medical record to a health care provider (Segal: pg. 3, par. [0028]).

Segal, however, fails to *expressly* disclose the system of claim 30, wherein:

under defined conditions.

Nevertheless, this feature is old and well known in the art, as evidenced by Judson. In particular, Judson discloses the method of claim 1, further comprising:

under defined conditions (Judson: pg. 8, par. [0105]).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Judson within the combined teachings of Segal, Joao, and Official Notice with the motivation of managing a user's (e.g., patient) medical data (e.g., genomic data) (Judson: pg. 1, par. [0010]).

(B) As per original claim 34, Segal fails to *expressly* disclose the system of claim 30, wherein:

communication interface is adapted to obtain said agreement before a defined condition arises.

Nevertheless, this feature is old and well known in the art, as evidenced by Judson. In particular, Judson discloses the method of claim 3, further comprising:

said agreement is obtained before a defined condition arises (Judson: pg. 8, par. [0105]).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Judson with the combined teachings of Segal, Joao, and Official Notice with the motivation of managing a user's (e.g., patient) medical data (e.g., genomic data) and decreasing unauthorized access to medical data (Judson: pg. 1, par. [0010] and pg. 8, par. [0105]).

7. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Segal, Joao, and Official Notice, as applied to claim 1 above, and further in view of Mok et al. (US 2003/0140044; hereinafter Mok).

(A) As per previously presented claim 9, Segal fails to *expressly* disclose the method of claim 1, further comprising:

said service provider inducing said patient to provide other information that is not a medical record, and storing said other information in said memory.

Nevertheless, this feature is old and well known in the art, as evidenced by Mok. In particular, Mok discloses the method of claim 1, further comprising:

said service provider inducing said patient to provide other information that is not a medical record, and storing said other information in said memory (Mok: pg. 14, par. [0127]).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Mok with the combined teachings of Segal, Joao, and Official Notice with the motivation of including other types of records where a person needs his/her records collected (Mok: pg. 14, par. [0127]).

(B) As per original claim 10, Segal fails to *expressly* disclose the method of claim 9, wherein:

said other information comprises information selected from the group consisting of a living will, investment portfolio, life insurance and a credit arrangement.

Nevertheless, this feature is old and well known in the art, as evidenced by Mok. In particular, Mok discloses the method of Claim 9, wherein:

said other information comprises information selected from the group consisting of a living will, investment portfolio, life insurance and a credit arrangement (Mok: pg. 14, par. [0127]) (The Examiner has noted insofar as claim 10 recites "selected from the group consisting of a living will, investment portfolio, life insurance and a credit arrangement," an investment portfolio has been recited.).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Mok with the combined teachings of Segal, Joao, and Official Notice with the motivation of including other types of records where a person needs his/her records collected (Mok: pg. 14, par. [0127]).

Response to Arguments

8. Applicant's arguments filed 9/17/07 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 9/17/07.

(A) On pages 13-28 of the 9/17/07 Appeal Brief, Applicant argues that the references applied in the rejections based on the combination of the teachings of Segal and Joao under 35 U.S.C. § 103(a) fail to disclose a service provider storing a medical record without data processing said medical record.

First, Examiner notes that Segal teaches that the patient provides his or her medical record to the service provider on a portable storage medium (e.g., medical bracelets, smart cards, etc.) so that the service provider could download the information into service provider's system—until the service provider actually downloads the patient's medical record and modifies it, NO "data processing" has occurred (Segal: pg. 12, ¶ [0151]).

Second, assuming *arguendo* that Segal does not teach storing a medical record without data processing, Joao clearly teaches storing medical records on storage mediums, such as smart cards. Moreover, Joao teaches that any of the entities, including service providers, may possess these portable medical records that have not been "processed" (Joao: col. 39, line 53-col. 40, line 2). Furthermore, Joao teaches that these portable medical records may be read (i.e., read without data processing) by appropriate reading devices (Joao: col. 40, lines 3-12). Lastly, even if these passages could be construed to disclose that "data processing" occurs after providing the portable medical record to the service provider, the fact remains the Joao clearly teaches 1) that the patient may possess the non-data-processed portable medical record (Joao: col. 39, lines 53-63) and 2) that any patient, user, provider, payer, and/or intermediary, may utilize the present invention in the same, similar and/or analogous manner (Joao: col. 4,

lines 26-33). In other words, a service provider may possess the non-data-processed portable medical record in the same manner as the patient.

(B) Applicant's remaining arguments in the Appeal Brief filed 9/17/07 rely on or re-hash the issues addressed above and/or previously given and therefore, are moot in view of the responses given above and/or in previous Office Actions and incorporated herein.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Tomaszewski whose telephone number is (571)272-8117. The examiner can normally be reached on M-F 7:00 am - 3:30 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571)272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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